

REMARKS

This paper is presented in response to the Office Action dated May 12, 2006. By this paper, claims 1 and 13 have been amended and new claim 24 has been added, such that claims 1-25 remain pending. Claims 1 and 13 are the only independent claims at issue.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Initially, Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments and to explicitly recite elements that were already inherently present in the claims. For example, claims 1 and 13 have been amended to clarify that 'the network address is received in a message from a message service in response to the originator submitting a request to the message service that a message be transmitted to the wireless mobile communication station.' Applicant has also added new claim 24, which recites an embodiment in which the originator communicates with the message service over a packet data network. Support for the claim amendments is found in at least the disclosure provided by Figure 1 and paragraphs [024], [027] and [040] – [041] of the specification as originally filed. In view of the foregoing, Applicant submits that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

I. Objection to the Specification

Paragraph 1 of the Office Action objects to the Abstract because of a minor informality which is now moot in view of amendments made to the Abstract. Applicant respectfully submits that the objection has been overcome and should be withdrawn.

II. Rejection based on Double Patenting

Claims 1 and 13 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 1 and 13, respectively, of U.S. Patent Application No. 09/771,121 (the "'121 Application'"). Applicant notes, however, that the '121 application was filed on the same day as the present application, namely, January 26, 2001.

Accordingly, the '121 application is not eligible for use in connection with an obviousness-type double patenting rejection inasmuch as they were filed on the same day. In light of the foregoing, Applicant respectfully requests that the provisional double patenting rejection of claims 1 and 13 be withdrawn.

III. Rejections based on 35 USC § 102

a. Rejection based on Seazholtz

Claims 1 and 13 were rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No. 5,920,821 to Seazholtz et al. However, Applicant respectfully submits that Seazholtz fails to anticipate or make obvious the claimed invention. In particular, Seazholtz fails to teach or suggest each and every claim element. The distinctions between Seazholtz and the present invention should now be even more apparent in view of the following discussions and amendments that have been made to clarify and explicitly recite elements that were already inherent in the claims.

Seazholtz is directed to a method and system of registering a cellular mobile subscriber with a cellular service carrier. See Abstract. In a cellular system each cellular carrier continuously broadcasts a system ID (SID) unique to the carrier on a cellular digital packet data (CDPD) radio frequency. See col. 2, lines 12-15. These SIDs are broadcast to no cellular station in particular, and are not sent in response to any request for broadcasting. Likewise, because each SID is broadcast, the SIDs are not sent to a message service, at least through a packet data network, as recited in claim 24. Upon powering up, a cellular station scans the CDPD frequency to determine which cellular carriers are currently available by receiving the broadcast SIDs. See col. 14, lines 35-43. The cellular station then determines which carrier to use by comparing the available SIDs against a list of preferred SIDs that has been stored in the cellular station. See col. 58-60. Based on this comparison, the cellular station acquires a carrier frequency registers with the carrier by using the preferred SID. See col 15, lines 18-24.

In view of the foregoing, it is clear that Seazholtz's SIDs are not broadcast to any particular cellular station in response to an originator submitting a request to the message service that a message be transmitted to a wireless mobile communication station, as claimed, for example, in the pending claims, particularly when considering the claims in their entirety.

Seazholtz does not disclose or suggest, for example, “receiving at the wireless mobile communication station a network address of an originator of packet data that is attempting to push the packet data to the mobile communication station, wherein the network address of the originator is received in a message from a message service in response to the originator submitting a request to the message service that a message be transmitted to the wireless mobile communication station,” as recited in amended claim 1, or “transmitting, to a message service provided by the wireless communication network, the originator’s own network address and a request to transmit a message that includes said network address to the wireless mobile communication station; [and] transmitting, to the wireless mobile communication station, from the message service, a message that includes said network address,” as recited in amended claim 13, and as recited in combination with the other recited claim elements. Accordingly, Applicant respectfully requests that the anticipation rejection of claims 1 and 13 based on Seazholtz be withdrawn.

b. Rejection based on Andersson

Claims 1, 2, 4-7, 11-14, 16-19, and 23 were also rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,047,194 to Andersson. Applicant respectfully submits, however, that Andersson also fails to anticipate or make obvious the claimed invention, as recited, for example, in claims 1, 2, 4-7, 11-14, 16-19, and 23.

Andersson fails, for example, to teach or suggest, among other things, a wireless communication station which establishes a packet data session with an originator of packet data using a received network address of the originator or using an identity corresponding to the received network address. Instead, Andersson discloses that a mobile terminal 14 initiates registration to enter into a packet state pursuant to packet communication registration procedures, after which packet data, which has already been routed from an Internet host 12 to a GPMSC 46 and then forwarded to a VPMSC 44, is forwarded from the VPMSC 44 and routed to the mobile terminal 14. See col. 7, lines 21-23; col. 7, lines 36-39; col. 8, lines 8-14; and col. 6, lines 63-64. Thus, Andersson does not teach or suggest, among other things, “establishing at [or from] the wireless mobile communication station, only after it is determined that the packet data reception from said originator is desired, a packet data session with said originator,” as recited in claims 1 and 13.

One principal difference between the present invention and Andersson is that the originator of the present invention does not need to have knowledge of the IP address allocated to the wireless terminal, whereas the Internet host 12 of Andersson clearly needs to have knowledge of such IP address. According to the present invention, since it is the wireless terminal that establishes the packet data session, the originator need not have knowledge of the IP address of the wireless terminal, but will be given permission to transfer packet data over the session established by the terminal (during which establishment the IP address will become known). Thus, the permission to transmit packet data to the wireless terminal follows from the fact that the wireless terminal establishes a packet data session using the network address, or a corresponding identity, of the originator of the packet data. In Andersson on the other hand, it is the registration to enter into a packet state which indicates such permission by enabling reception of packet data that has already been transmitted. See col. 8, lines 8-14.

The solution of the present invention is advantageous since it eliminates the need by an originator to make inquiries to appropriate repositories for receiving an unknown packet data network address currently allocated to the wireless terminal. Such inquiries will result in drawbacks relating to consequences of signaling load against the repository storing the packet data address, changes of packet data address allocated to the wireless terminal from time to time, and the routing of requests for such packet data address to different repositories (all of which drawbacks are mentioned in the background section, and their elimination in the summary of the invention section, of the present application). Furthermore, the packet data is not transferred until it is determined that the mobile station wants to receive the data.

Andersson teaches a different way of selectively permitting/denying the reception of packet data transmitted from an Internet host. Andersson teaches that a host transmits packet data to the terminal using a known IP address and that the terminal decides whether or not to enter a packet state for receiving the packet data. If the skilled person were to modify Andersson such that the host were to acquire the IP address of a terminal, he might recognize that such IP addresses may be received from appropriate repositories of the radio communication network. However, such a modification of Andersson would not result in the subject-matter claimed by the present invention.

Accordingly, Applicant respectfully requests that the anticipation rejection of claims 1, 2, 4-7, 11-14, 16-19, and 23 based on Andersson be withdrawn.

IV. Rejections based on 35 USC § 103

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP § 2143*.

Claims 3, 8, 9, 15, 20, and 21 were rejected under 35 USC § 103(a) as being unpatentable over Andersson in view of U.S. Patent No. 6,614,774 to Wang or U.S. Patent No. 6,822,955 to Brothers. Wang is cited for allegedly establishing a packet data session with an address translation server. Brothers is cited for purportedly disclosing an identity that is an internet domain host name of a network server. Applicant submits that neither Wang nor Brothers cure the deficiency of Andersson as discussed above. Thus, even if, *arguendo*, Andersson and Wang or Brothers were combined in the purportedly obvious manner set forth in the Office Action, the resulting combination would still not disclose or suggest, among other things, “establishing at [or from] the wireless mobile communication station, only after it is determined that the packet data reception from said originator is desired, a packet data session with said originator,” as required in claims 3, 8, 9, 15, 20, and 21, by virtue of their dependence from claims 1 and 13, respectively.

Accordingly, because the Office Action has failed to establish a *prima facie* case of obviousness with respect to claims 3, 8, 9, 15, 20, and 21, as detailed above, Applicant respectfully requests that the obviousness rejection of claims 3, 8, 9, 15, 20, and 21 be withdrawn.

CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-25 is in condition for allowance.¹ Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 11th day of August, 2006

Respectfully submitted,



Jens C. Jenkins
Registration No. 44,803
Scott A. Woodbury
Registration No. 55,743
Attorneys for Applicant

Customer No. 022913
Telephone No. 801.533.9800

JCI:SAW:ahy
W:\152924\AHY0000001170V001.DOC

¹ In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.